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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,286	02/09/2006	Erwin G. Van Meir	050508-1360	9545
24504 7590 04/28/2009 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 600 GALLERIA PARKWAY, S.E. STE 1500 ATLANTA, GA 30339-5994				
EXAMINER ANDERSON, REBECCA L				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,286

Applicant(s)

VAN MEIR ET AL.

Examiner

REBECCA L. ANDERSON

Art Unit

1626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 55 and 68-76 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 55, 68 and 69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 and 70-76 is/are rejected.
- 7) ☒ Claim(s) 7-13 and 70-76 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/30/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-13, 55 and 68-76 are currently pending in the instant application.

Claims 1-6, 55, 68 and 69 are withdrawn from consideration as being for non-elected subject matter. Claims 7-13 and 70-76 are rejected and objected.

Election/Restrictions

Applicant's election without traverse of Group II, and the species of claim 55 in the reply filed on 26 February 2009 is acknowledged.

As per MPEP 803.02, the examiner will determine whether the entire scope of the claims is patentable. Applicants' elected species is not allowable. Therefore, according to MPEP 803.02:

Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable **, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.
the elected species shall be rejected, and claims to the nonelected species will be held withdrawn from further consideration.

As the elected species has been found not allowable, the Markush-type claims have been rejected and claims to the nonelected invention held withdrawn from further consideration. **Claims 7-13 and 70-76 have been examined to the extent that they are readable on the elected embodiment, the elected species as seen in claim 55.** Since the elected embodiment is not allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration. 1-6, 55, 68 and 69 are therefore withdrawn from consideration as being for non-elected subject matter. It has been determined that the entire scope claimed is not patentable.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claims 7-13 and 70-76 are objected to as containing non-elected subject matter. Claims 7-13 and 70-76 presented drawn solely to the elected embodiment identified supra would overcome this objection.

Specification

The disclosure is objected to because of the following informalities: Specifically, some page numbers are missing, such as page "33".

Appropriate correction is required.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because of the following informalities. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted

by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

The drawings are objected to because Figure 2 and 3 contain text that is too small and Figure 4 cannot be discerned due to the poor quality of the copy. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and

where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 70-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 70-76 are dependent upon claim 55 which is drawn to products, salts, derivatives or prodrugs thereof. The term "derivative" renders the claims indefinite as the definition in the specification is only that a derivative is a "modification to the disclosed compounds". The term "derivative" is a compound, usually organic obtained from another compound by a simple chemical process or an organic compound containing a structural radical similar to that from which it is derived. Applicant has not provided what similar radicals are encompassed by the instant claims which therefore renders the claims indefinite.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1626

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7-13 and 70-76 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the inhibition of HIF-1 activity and inhibition of gene transcription does not reasonably provide enablement for the treatment (which includes prevention, see page 13 of the specification) or prevention of a hypoxia-related pathology, for the modulation of HIF-1 activity or for the modulation of gene transcription. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

As stated in the MPEP 2164.01 (a), "There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue."

In In re Wands, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

In the instant case,

The nature of the invention

The nature of the invention of the claims is the treatment and prevention of hypoxia-related pathologies, such as cancer, modulation of HIF-1 activity and modulation of gene transcription. Furthermore, the instant claims cover 'diseases' that are known to exist and those that may be discovered in the future, for which there is no enablement provided.

The state of the prior art and the predictability or lack thereof in the art

The state of the prior art is that the pharmacological art involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities (i.e. what compounds can treat or prevent which specific diseases by what mechanism and whether the compound inhibits or activates or modulates). There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

The instant claimed invention is highly unpredictable as discussed below:

It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. In re Fisher, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute.

Applicants are claiming the treatment and prevention of hypoxia-related pathology such as cancer.

The state of the prior art is that cancer therapy remains highly unpredictable. The various types of cancers have different causative agents, involve different cellular mechanisms, and consequently, differ in treatment protocol. It is known that the challenge of cancer treatment has been to target specific therapies to pathogenetically distinct tumor types, that cancer classification has been based primarily on morphological appearance of the tumor and that tumors with similar histopathological appearance can follow significantly different clinical courses and show different responses to therapy (Golub et al. page 531) Furthermore, it is known that chemotherapy is most effective against tumors with rapidly dividing cells and that cells of solid tumors divide relatively slowly and chemotherapy is often less effective against them. It is also known in the prior art (Lala et al. page 91) that the role of NO in tumor biology remains incompletely understood with both the promotion and inhibition of NO mentioned for the treatment of tumor progression and only certain human cancers may be treated by selected NO-blocking drugs. These example shows that there are different cellular mechanisms, the unpredictability in the art and the different treatment protocols.

Hence, in the absence of a showing of correlation between all the diseases claimed as capable of treatment or prevention by the administration of the compounds of the claims one of skill in the art is unable to fully predict possible results from the administration of the compound of the claims due to the unpredictability, for example, since it is known that the challenge of cancer treatment has been to target specific therapies to pathogenetically distinct tumor types, that cancer classification has been

based primarily on morphological appearance of the tumor and that tumors with similar histopathological appearance can follow significantly different clinical courses and show different responses to therapy.

The amount of direction or guidance present and the presence or absence of working examples

The only direction or guidance present in the instant specification is the listing of diseases applicant considers as treatable or preventable on pages 33-35. In vitro data is discussed on pages 56 and 57 for the inhibition of HIF-1. However, the disclosure does not provide how the in vitro data correlates to the treatment or prevention of the assorted diseases claimed, nor the modulation of HIF-1 or gene transcription.

The uses covered by the claims are not enabled based solely on the assay testing reported in the specification. Various studies reported for compounds in clinical development rely on animal models and not simply assay testing as done herein. Note Hoffman V. Klaus 9 USPQ2d 1657 regarding the standard of testing that is necessary to establish the likelihood of in vivo use. Also see Ex parte Powers 220 USPQ 925. Where the utility is unusual or difficult to treat or speculative, the examiner has authority to require evidence that tests relied on are reasonably predictive of in vivo efficacy by those skilled in the art. See for example, In re Ruskin 148 USPQ 221; Ex parte Jovanovics 211 USPQ 907. Any evidence relied on by applicants must clearly show a reasonable expectation of in vivo success for any additional diseases that may still be embraced in response to this action. See MPEP 2164.05(a).

Additionally, for example, in regards to the treatment of specific cancers, in general, cell culture studies are not considered, in the cancer arts, to be reliably

predictive of effects in cancer treatment, in vitro assays cannot easily assess host-tumor and cell-cell interactions that may be important in the malignant state and cannot duplicate the complex conditions of in vivo therapy. This is because characteristics of cultured cell lines generally differ significantly from the characteristics of a primary tumor. Those of skill in the art recognize that *in vitro* assays are useful to screen the effects of agents on cells. However, clinical correlations are generally lacking. The greatly increased complexity of the *in vivo* environment as compared with the very narrowly defined and controlled conditions of an *in vitro* assay does not permit a simple extrapolation of *in vitro* assays to human therapeutic efficacy with any reasonable degree of predictability.

Further, there is no disclosure regarding how all types of diseases claimed having diverse mechanisms are treated. Receptor activity is generally unpredictable and a highly structure specific area, and the data provided is insufficient for one of ordinary skill in the art in order to extrapolate to the other compounds of the claims. It is inconceivable as to how the claimed compounds can treat the extremely difficult diseases embraced by the instant claims.

Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use of the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved." See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

The breadth of the claims

The breadth of the claims is methods of treating or preventing hypoxia-related pathologies, modulating HIF-1 activity and modulating gene transcription.

The quantity of experimentation needed

The quantity of experimentation needed is undue experimentation. One of skill in the art would need to determine what diseases out of the multitude claimed would be benefited (treated or prevented) by the administration of the compound of the claims and how the inhibition of HIF-1 activity can modulate (which can include activating) HIF-1 activity or gene transcription.

The level of the skill in the art

The level of skill in the art is high. However, due to the unpredictability in the pharmaceutical art, it is noted that each embodiment of the invention is required to be individually assessed for physiological activity by in vitro and in vivo screening to determine which compounds exhibit the desired pharmacological activity and which diseases would benefit from this activity.

Thus, the specification fails to provide sufficient support of the broad use of the compound of the instant claims for the treatment or prevention of the various claimed diseases and disorders as a result necessitating one of skill to perform an exhaustive search for which disorders can be treated or prevented by what compounds of the instant claims in order to practice the claimed invention.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instantly claimed methods. In view of the breadth of the claim, the chemical nature of the invention, and the lack of working examples regarding the activity of the claimed compounds, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the invention commensurate in scope with the claims.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001 , states that " a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

Therefore, in view of the Wands factors and *In re Fisher* (CCPA 1970) discussed above, to practice the claimed invention herein, a person of skill in the art would have to engage in undue experimentation to test which diseases can be treated or prevented by the compound encompassed in the instant claims, with no assurance of success.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the
Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

24 April 2009

Rebecca Anderson
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